

## REMARKS

The pending Office Action addresses claim 1, 3, and 5-19. Claims 1, 6, and 8-10 are rejected, claims 3, 5, and 7 are objected to, and claims 11-19 are allowed.

### ***Rejection Pursuant to 35 U.S.C. §103***

Claims 1, 6, and 8-10 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,667,664 of Taylor in view of U.S. Publication No. 2003/0065391 of Re et al. The Examiner argues that Taylor teaches the claimed invention except for the elongate stem portion having an enlarged head. The Examiner relies on Re to teach this feature, arguing that it would have been obvious to modify the device of Taylor in view of Re to arrive at the claimed invention as the combination would result in a device that would be able to be used in an easier manner.

Applicant respectfully disagrees.

In fact, Applicants disagree with the Examiner's assertion that Taylor discloses all claimed elements except for the elongate stem having an enlarged head. Taylor also fails to teach or suggest that the guide member is configured to be *selectively moveable and lockable along a length of the arm portion*, as required by independent claims 1 and 11.

The device of Taylor is used for orthopedic surgery and includes a transverse support arm (42), which the Examiner asserts is the claimed arm portion, and a targeting mechanism (46), which the Examiner asserts is the claimed guide member, that is mounted on a distal end of the arm (42). The arm (42) includes telescoping sections for changing the overall length of the arm (42) to allow movement of the position of the targeting mechanism (46). Specifically, the length of the arm (42) can be varied only by sliding the telescoping sections *of the arm (42)* in order to change the location of the targeting mechanism (46). The targeting mechanism itself clearly is not movable *along the length of the arm* as required by the claims. Rather, the length of the arm itself is altered to change the position of the targeting mechanism (46) with respect to the patient – but the targeting mechanism always stays in the *same location relative to the arm* as the length of the arm is altered.

Re does not remedy the deficiencies of Taylor as Re also does fails to teach or suggest a guide member that is selectively moveable and lockable along the length of the arm portion. Re is directed to an installation tool for use with a support block to hold a ligament that includes a holder (205) and a drill guide (210), shown in FIG. 9 of Re. The only components of Re that could possibly form the claimed arm portion and the guide member are the portion of the drill guide (210) that is parallel to the holder (205) and the drill sleeve (270). The drill sleeve (270) is positioned at the end of the drill guide (210) by threading through a bore formed in the drill guide (210). The drill sleeve (270) thus is not able to move along the length of the drill guide (210) as it is fixed relative to the drill guide (210) due to its position within the bore formed therein. Thus, neither Taylor nor Re teach this feature of the claims.

Further, as explained in the previous response, Taylor cannot be modified to add the enlarged head taught by Re as suggested by the Examiner as there simply is no motivation for making such a modification. The Examiner asserts that the intramedullary nail (18) of Taylor, which is adapted to be implanted into a fractured femur, corresponds to the claimed rod member. As explained in Column 5, lines 11-17 of Taylor, the intramedullary canal of the femur is reamed about 1 millimeter larger than the diameter of the nail (18) that is introduced therein. An enlarged head would prevent the nail from fitting within the reamed area of the canal. Even if the size of the space in the canal was increased to accommodate an enlarged head on the nail, the remaining portion of the nail would not fit properly within the canal as there would be too much extra room within the canal because of the need to accommodate the enlarged head. In addition, it would not have been obvious to enlarge the space reamed in the femur as this would further weaken the femur, which already includes a fracture requiring the implantation of the nail (18). The suggested modification is therefore not obvious.

In the response to Applicants' arguments, the Examiner argues that

the test for combining references is which the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

[R]eferences are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, it would have been obvious to combine Taylor et al. with an enlarged head in view of Re et al., in order to have device that would facilitate tissue graft attachment.

Applicants disagree with the Examiner's assessment of the references. No person of ordinary skill in the art, even when simply evaluating the suggestions taught in the disclosure of Taylor, would combine the intramedullary nail of Taylor with the enlarged head as taught in Re. Nobody would combine these references in order to create a device to tissue graft attachment, as suggested by the Examiner, because the device of Taylor is used for orthopedic surgery, and nothing in the disclosure suggests use of the device for any other purposes, and certainly not for tissue graft attachment.

Accordingly, claim 1, as well as claims 6 and 8-10 which depend therefrom, distinguish over the combined references and represent allowable subject matter.

### ***Conclusion***

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

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Respectfully submitted,

By: Electronic Signature: /William C. Geary/  
William C. Geary III  
Registration No.: 31,359  
NUTTER MCCLENNEN & FISH LLP  
World Trade Center West  
155 Seaport Boulevard  
Boston, Massachusetts 02210-2604  
(617) 439-2766  
(617) 310-9766 (Fax)  
Attorney for Applicant